

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
FOWLKES, et al.)
Serial No.: 09/050,359)
Filed: March 31, 1998)
For: IDENTIFICATION OF DRUGS)
USING COMPLEMENTARY...)

Art: 1627
Examiner: WESSENDORF, T.
Washington, D.C.
July 3, 2001
Docket No.: FOWLKES=4B

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RESPONSE TO MISCELLANEOUS COMMUNICATION

Commissioner of Patents
Washington, D.C. 20231

S i r :

1. In response to the miscellaneous communication mailed June 19, 2001, as to the references previously filed in 08/740,671, as explained in the May 24, 2000 amendment, at page 5, 37 CFR 1.98(d) specifically states

A copy of any patent, publication or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the Office in a prior application, provided that the prior application is properly identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120.

In the IDS filed October 21, 1999, in section B, bridging pages 2-3, we said:

Certain documents were previously cited by or submitted to the Office in the following prior application(s), which are relied upon under 35 U.S.C. 120:

USSN 08/740,671, filed October 31, 1996.

Applicants identify these documents by attaching hereto copies of the form PTO-892s and PTO-1449s from the files of the prior applications or a fresh PTO-1449 listing these documents, and request that they be considered and made of record in accordance with 1.98(d). Per 37 CFR 1.98(d), copies of these documents need not be filed in this application.

Hence, Applicants do not need to furnish copies.

2. With regard to the references newly cited in the October 21, 1999 IDS, we have supplied proof that copies were filed. See January 4, 2001 Request to Vacate.

3. With regard to the additional references cited by the Examiner at page 16 of the November 29, 1999 office action, it is unclear to us whether they are included in the present request for copies.

In the Request to Vacate filed January 4, 2001, we assumed (because of the wording of page 16 of the November 29, 1999 action) that these "additional references" were not of record. However, Counsel was mistaken. All of the references in question were cited against the case by Examiner McCarthy on a PTO-892. Hence, they are already of record and copies should be in the Examiner's file. Copies should also have been provided to us, see MPEP 707.05(a), but weren't.

4. In a telephonic interview on July 3, 2001, the Examiner conceded that the PTO should not have required submission of copies, i.e., the communication mailed June 19 was based on a false assumption. The Examiner will make the references cited October 21, 1999 of record, and consider them. If courtesy copies are desired (because the originals are missing from the parent file, the Examiner will call counsel prior to July 12 - Counsel is out of the country July 12-31- to request them).

Respectfully submitted,

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